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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,810	12/17/1999	DAVID D. BOHN	10991692-1	7982

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EXAMINER

LESPERANCE, JEAN E

ART UNIT PAPER NUMBER

2674

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/471,810

Applicant(s)

BOHN, DAVID D.

Examiner

Jean E Lesperance

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-12,14-16 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-31 is/are allowed.
- 6) ☒ Claim(s) 1-5,7-12, and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. This application, filed under former 37 CFR 1.60, lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings. In unusual circumstances, the formal drawings from the abandoned parent application may be transferred by the grant of a petition under 37 CFR 1.182.
2. The After Final filed on 10/13/2004 is entered.
3. The allowable subject matter of the currently amended claims 1 and 8 are withdrawn from consideration and new Office Action is provided below.
4. Claim 1-5, 7-12, 14-16 and 27-31 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 7-12 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 8, the phrase "may be" renders the claim indefinite because it is unclear whether the first button is operated or not operated. The correct phrase should be "the first button is operated". Correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent # 6,137,479 ("Olsen et al.").

As to claims 1, 8, Olsen et al. teach a display Fig.2A (34) wherein an image is displayable on said display; a roller ball Fig.2A (42) mounted on the bottom of the computer mouse 20 to detect the movement of the computer mouse 20 and to control the position of the cursor on the display screen 34 corresponding to a navigation sensor whereby a movement of said mouse is sensed by said roller and said movement includes moving said display and produces a change in said image; button Fig.2A (28) generate signals to initiate an operation associated with an item displayed on the display screen 34 and a user can select an icon on the display screen 34 by depressing the appropriate button when the cursor is positioned over an icon corresponding to a first button operated in cooperation to mimic at least one function of a computer mouse being used with a graphical user interface. The prior art does not explicitly teach a first button to mimic at least one function. However, the prior art teaches a user can select an icon on the display screen 34 by depressing the appropriate button when the cursor is positioned over an icon. Thus, it would have been obvious to a person of ordinary skill

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in the art to modify a user can select an icon on the display screen 34 by depressing the appropriate button when the cursor is positioned over an icon to achieve the function of a first button to mimic at least one function because this would provide a combined computer mouse and a portable programmable computer.

As to claims 2-5 and 9-12, Olsen et al. teach a roller ball Fig.2A (42) to control the position of the cursor on the display screen 34 corresponding to wherein said change comprises at least moving a cursor, a least panning at least part of said image, a least scrolling at least part of said image and a least navigating at least part of said image showing on the display.

As to claims 14 and 16, Olsen et al. teach the computer mouse Fig.2A (20) includes conventional computer mouse components for using the computer's graphical user interface.

As to claim 15, Olsen et al. teach a button Fig.2A (28) generate signals to initiate an operation associated with an item displayed on the display screen 34 and a user can select an icon on the display screen 34 by depressing the appropriate button when the cursor is positioned over an icon.

### ***Allowable Subject Matter***

7. Claims 27-31 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: the claimed invention is directed to an electronic scanning device. Independent claim 27 identifies a uniquely distinct feature "an image sensor for scanning an image; a

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display that displays a first part of a scanned version of said image, a navigation sensor that detects relative movement between said scanning device and a surface in close proximity to said navigation sensor whereby said relative movement changes said display to displaying a second part of said scanned version of said image". The closest art Berry et al. as discussed above fails to anticipate or render the above underlined limitations obvious.

### **Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean Lesperance whose telephone number is (703) 308-6413. The examiner can normally be reached on from Monday to Friday between 8:00AM and 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709 .

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or


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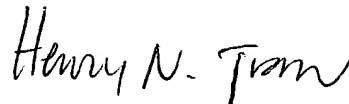
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proceeding should be directed to the technology Center 2600 Customer Service Office  
whose telephone number is (703) 306-0377.

Jean Lesperance

  
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Date 12-14-2004



HENRY N. TRAN  
PRIMARY EXAMINER